

means for determining differences between the first workspace data and the second workspace data;

means for storing the differences at a global server; and

means for sending the differences from the global server to the second device.

#### REMARKS

Claims 83 through 96 were pending in the present application when last examined and were finally rejected. Claims 83 and 90 are being amended herein for greater clarity. No new matter is being added, and claims 83 through 96 remain pending in the present application.

#### Objections/Rejections under 35 U.S.C. § 112

In items 2 on page 2, of the Office Action, the Examiner objected to the specification under 35 U.S.C. § 112, first paragraph, "as failing to provide an adequate written description of the invention and failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure."

Regarding claims 86 and 93, the Examiner asserts that "Applicant did not teach the details of how the smart phone, a television settop box provided workspace data including the difference as claimed in claims 86 and 93. It would take undue experimentation for one of ordinary skill in the art at the time of the invention to determine the details of the smart phone and a television settop box as claimed in the claims" (emphasis added).

Regarding claims 85 and 92, the Examiner also asserted that "[A]pplicants on page 23 of the specification stated in a summary fashion that although not shown, other services such as bookmarking may be included in the list. This kind of information is not enabling. The specification is the place where [A]pplicants must teach the details of the features of the invention if the applicant wants to claim such features in the claims. It would take further undue experimentation for one of ordinary skill in the art to determine the details of the bookmark data as claimed in claims 85 and 92" (emphasis added).

The Examiner further, in item 3 on page 2 of the Office Action, rejected claims 85-86 and 92-93 under 35 U.S.C. § 112, first paragraph, "for the reasons set forth in the objection to the specification."

Applicants respectfully traverse the objection and rejection.

Applicants, being confused by the objection, rejection and a further rejection given below, requested and the Examiner granted a telephone interview. Applicants thank the Examiner for agreeing to conduct the telephone interview.

The following is contained in the Examiner's Interview Summary. "Continuation of [the] Substance of Interview including [a] description of the general nature of what was agreed to if an agreement was reached, or any other comments: Attorney called the [E]xaminer to discuss the 112 first paragraph issies [sp] as well as the [prior] art rejection. [The] Attorney stated that his clients stated that their application runs on settop boxes as well as smart phones. [The] Examiner stated that the specification must show details of the settop boxes or smart phones because these are limited devices by memory and processing powers [sp] and thus an application which runs on a desktop computer cannot run on these small portable devices without modification and optimizations[,] and thus there is no support in the specification for these features. [The] Attorney also argued that the cited references do not show the synchronization features. [The] Examiner pointed out that the claims do not recite any synchronization features. [The] [c]laims are drafted to read on screen updating on conferencing systems with server control and the cited references taught what the claims recite" (emphasis added).

Applicants' Attorney respectfully notes that the Examiner's summary is neither wholly accurate nor wholly complete. More specifically, the Examiner admitted that the Examiner lacked certain understanding of particularly the cited prior art, and was merely guessing as to what would or would not be known by one of ordinary skill at the time of the invention. The Examiner was also especially unfamiliar with the specificities upon which his objection and rejection were based. The Examiner also knew without prompting that the claims recited synchronization embodiments and that a new search was NOT necessitated by the prior amendment of the claims, and was informed but refused to consider further pertinent references in the specification or that the finality of the Office Action might have been improper. The Examiner would not even consider and would summarily reject an Amendment after Final.

Applicants respectfully remind the Examiner generally that, as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112 is satisfied. *In re Fisher*, 427 F.2d 833, a 39, 166 USPQ 18, 24 (CCPA 1970). Further, failure to

disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. § 112. *Spectra-Physics, Inc. vs. and Coherent, Inc.*, a 27 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), cert. denied, 484 U.S. 954 (1987). See also MPEP 2164.01(b).

Applicants also remind the Examiner that, it is improper to conclude that the disclosure is not enabling based on an analysis of only one of [the breadth of the claims; the nature of the invention; the state of the prior art; the level of one of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the content of the disclosure] while ignoring one or more of the others. The Examiner's analysis must consider related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *In re Wand*, 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407. See also MPEP 2164.01(a). "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). See also MPEP 2164.01.

In the present case, the Examiner has only conducted a cursory (and inaccurate) review of the disclosure and postulated, without evidence, an inaccurate level of skill in networking as "ordinary". Rather, the specification provides several examples that adequately enable the invention and the embodiments thereof recited by the rejected claims.

For example, the Examiner bases his objection to the specification and rejection of claims 86 and 93 on the proposition that limited memory and processing power of smart phones or settop boxes renders them incapable of running desktop computer applications. However, in even a general sense, it was common knowledge at the time of the invention that portable versions of PC-based operating systems were being developed, such as Windows CE, for running applications on portable devices. Moreover, it was necessarily within the knowledge and skill of ALMOST ANYONE able to secure work networking at the time of the invention to otherwise implement general storing, determining and sending using applicable devices, and the specification need not include the manual for any, let alone every such device. Still further, the specification refers not to a PC as a point of reference (as the Examiner apparently contends), but discloses an example in which "any connected terminal having a web engine, such as an Internet-

enabled smart phone, [or] television settop (e.g., web TV)" at page 7, lines 6-7. The specification further details how storing, determining and sending might be conducted for workspace data by such connected terminals. (See, for example, FIGS. 1, 4, 6, 7 and 10-15.)

Certainly the Examiner cannot support that one of ordinary skill would have required undue experimentation, for example, to use a portable-device browser, memory map, data link or file access/data compare features to store or determine differences between workspace data. The Examiner is further reminded that that a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). See also MPEP 2164.01.

Thus, contrary to the Examiner's assertions, the "storing", "determining" and "sending" of claim 83 or the means for storing, determining and sending of claim 90 could IN FACT be conducted/ implemented in a similar manner and in accordance with teachings of the specification using a smart phone, television settop box or PC, such as in respective dependent claims 86 and 93.

The Examiner further infers that bookmarks have unique insufficiently disclosed characteristics, without any support or guidance as to what these might be, and further infers that the specification lacks enabling support and provides only the above summary sentence. However, first, bookmark data could -at the time of the invention- generally be stored, used for determining and sent in a similar manner as with any other workspace data in accordance with the embodiments of the specification or those recited by claims 85 and 92. Further, where a difference might require elaboration, such elaboration was sufficiently enabled by the specification. (See, for example, the exemplary bookmark in global format of FIG. 5, and the entirety of the Summary and Detailed Description.)

As to the Examiner's unsupported suggestion that moving from a PC (which was not specified as a basis for comparison) to a suitably configured smart phone or settop box (not inconsistent with the teachings of the specification), re-compiling code, reviewing a memory map or device features, and so on would have been a common practice by any self-respecting practitioner of ordinary skill in the art at the time of the invention. The Examiner is reminded that, the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983). Further, the test of

enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). See also MPEP 2164.01. Certainly, the Examiner cannot support that, for example, ordinary file/memory access or data comparing is above ordinary knowledge, that consulting a manual for a subject device, if required, is undue, that ordinary testing of software is undue or that excluding specific instructions for otherwise common practices for every existing or future device is required to avoid such objection/rejection.

Therefore, for at least the foregoing reasons, it is respectfully submitted that the objection to the specification and rejection of claims 85-86 and 92-93 under 35 U.S.C. § 112, first paragraph, "for the reasons set forth in the objection to the specification" were improper. Withdrawal of the objection and rejection are therefore solicited.

**Rejections under 35 U.S.C. § 102(a)**

In items 4 and 5 that begin on page 3 of the Office Action, the Examiner rejected claims 83 through 96 under 35 U.S.C. § 102 (a) as being anticipated by U.S. Patent No. 6,343, 313 to Salesky et al. (hereinafter referred to as "Salesky").

The Examiner asserts that Salesky "taught the invention as claimed including a system comprising: a) means for storing first workspace data on a first device (at 7:35 et seq.), b) means for storing second workspace data on a second device (8:3 et seq.); c) means for determining differences between the first workspace data and the second workspace data (7:38-65); d) means for storing the differences at a global server (7:66-67); and e) means for sending the differences from global server to the second device (8:1 et seq.). Applicants respectfully traverse.

Claim 83 as amended recites:

83. (Once Amended) A method for synchronizing workspace data,  
comprising:  
    storing first workspace data on a first device;  
    storing second workspace data on a second device;

determining differences between the first workspace data and the second workspace data;  
storing the differences at a global server; and  
sending the differences from the global server to the second device.

Clearly, since the Examiner agreed during the telephone interview that the conferencing system of Salesky does not teach or suggest synchronization, the rejection is moot by way of the amendment herein. It should be noted, however, that the Examiner was already WELL aware that the claims were drawn to synchronization of workspace data, even by a simple reading. The Examiner was also aware that Salesky instead teaches "presenter client conferencing software... in which "during a conferencing session, presenter client takes periodic 'snapshots' of the application screen image..." for which changes to the displayed graphics or video are determined via application of an exclusive-OR function and are broadcast to other conference members (e.g., see col. 7, lines 21-67).

Thus, the embodiment recited by claim 83, particularly as amended, clearly distinguishes over Salesky. Similarly, the Examiner agreed that the embodiment recited by claim 90, as amended, and which now recites the following, is neither taught nor suggested by Salesky:

90. (Once Amended) A system for synchronizing workspace data,  
comprising:

means for storing first workspace data on a first device;  
means for storing second workspace data on a second device;  
means for determining differences between the first workspace data and  
the second workspace data;  
means for storing the differences at a global server; and  
means for sending the differences from the global server to the second  
device.

Applicants further assert the same arguments with respect to claim 90 as are asserted with respect to the remaining claims. Thus, for at least the foregoing reasons, Applicants submit that claims 83 and 90 are patentable over Salesky.

The remaining rejected claims 84-89 and 91-96 depend from claims 83 and 90, are also neither taught nor suggested by Salesky, and are patentable over Salesky for at least the same reasons that claims 83 and 90 are patentable over Salesky.

Withdrawal of the objections and rejections and early allowance of claims 83 through 96 is therefore respectfully requested.

It is further unclear to the Applicants how the Examiner might find support for the conferencing system of Salesky and not for smart devices, settop boxes or bookmarks (see above). It is further unclear how the Examiner might make the above objection and rejection on the above assertions and then, conversely, state the following basis for the rejection of claims 85-86 and 92-93 in item 11: "Applicant also on page 23 of the specification stated that although not shown, other services such as bookmarking may be included in the list. [The] Examiner is using the same rational [which he earlier objected to and used to reject claims] and saying [sp] that these features are [an] inherent part of the web based systems and there may be more to be added to this list of services." Therefore, Applicants respectfully request clarification and withdrawal of the finality of the Action.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**" Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney at (650) 843-8796.

**Version 5 With Markings To Show Changes Made****In the claims:**

Claims 83 and 90 are amended herein as follows. Claims 83 and 90 are further marked with a double asterisk (\*\*), and the remaining pending claims are provided in 11 point and italics for the Examiner's convenience.

- \*\* 83. (Once Amended) A method for synchronizing workspace data, comprising:  
storing first workspace data on a first device;  
storing second workspace data on a second device;  
determining differences between the first workspace data and the second workspace data;  
storing the differences at a global server; and  
sending the differences from the global server to the second device.
84. *The method of claim 83, wherein the first workspace data comprises a workspace data element from a first user of the first device to a second user of the second device.*
85. *The method of claim 84, wherein the workspace data element includes data selected from a group including email data, file data, calendar data, user data and bookmark data.*
86. *The method of claim 83, wherein at least one of the first device and the second device is selected from a group including a smart phone, a television settop box and a personal computer.*
87. *The method of claim 83, further comprising continuing to store the differences at the global server is continued after the sending.*
88. *The method of claim 83, further comprising storing at the server version-indicating information corresponding to the differences.*
89. *The method of claim 83, further comprising merging, by the second device, the differences with third workspace data stored on the second device.*

- \*\* 90. (Once Amended) A system for synchronizing workspace data, comprising:
- means for storing first workspace data on a first device;
  - means for storing second workspace data on a second device;
  - means for determining differences between the first workspace data and the second workspace data;
  - means for storing the differences at a global server; and
  - means for sending the differences from the global server to the second device.
91. *The system of claim 90, wherein the first workspace data comprises a workspace data element from a first user of the first device to a second user of the second device.*
92. *The system of claim 91, wherein the workspace data element includes data selected from a group including email data, file data, calendar data, user data and bookmark data.*
93. *The system of claim 90, wherein at least one of the first device and the second device is selected from a group including a smart phone, a television settop box and a personal computer.*
94. *The system of claim 90, further comprising means for continuing to store the differences at the global server is continued after the sending.*
95. *The system of claim 90, further comprising means for storing at the server version-indicating information corresponding to the differences.*
96. *The system of claim 90, further comprising means for merging, by the second device, the differences with third workspace data stored on the second device.*